REMARKS

This is a full and timely response to the final Official Action mailed November 8, 2005. Reconsideration of the application in light of the following remarks is respectfully requested.

Claim Status:

Claims 5-8, 12 and 32-35 remain pending for further action.

Prior Art:

With regard to the prior art, the outstanding Office Action made two rejections.

(1) Claims 6, 8, 12, 33, 35 and 43 were rejected as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,546,210 to Nakamura ("Nakamura"); and

(2) Claims 5-8, 12 and 32-35 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Nakamura, U.S. Patent No. 5,373,718 to Honma et al. ("Honma") and U.S. Patent No. 3,767,188 to Rosenberg ("Rosenberg").

For at least the following reasons, these rejections are respectfully traversed.

Claim 5 recites:

> A ream of print medium in a media wrapper for use in a printing device comprising:
> a quantity of print medium configured to be automatically fed into a printing device for formation of images thereon; and
> a wrapper containing said quantity of print medium, said wrapper comprising:
> a first end;
> a second end;
> a perforation disposed between said first and second ends, wherein said perforation is configured to split said media wrapper to separate said first and second ends such that said first end is removed to expose said quantity of print medium; and

a pull-tab, wherein said pull-tab is configured to split said perforation and said pull tab comprises an extruded portion of said media wrapper. (emphasis added).

Similarly, claim 32 recites:

A packaged print medium in a media packaging wrapper for use in a document producing device comprising;
a quantity of print medium;
a wrapping means for wrapping said print medium;
a separating means for separating said wrapping means, such that a first portion of said wrapping means is removed, while a second portion remains around said print medium providing support to said quantity of print medium, wherein said separating means comprises a pull-tab; and
wherein said pull tab comprises an extruded portion of said wrapping means. (emphasis added).

The recent Office Action gives the definition of "extruded" as being "to project or protrude." (Action of 11/08/05). However, this definition is largely incomplete and conveys an inaccurate meaning of the term "extruded." "Extruded" is more accurately defined in the art as follows:

**Merriam-Webster Online Dictionary:** 1 : to force, press, or push out 2 : to shape (as metal or plastic) by forcing through a die. (http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=extruded)

**Cambridge Online Dictionary:** to form something by forcing or pushing it out, especially through a small opening. (http://dictionary.cambridge.org/define.asp?key=27325&dict=CALD)

**Dictionary.com:**
*v. tr.*
1. To push or thrust out.
2. To shape (a plastic, for instance) by forcing it through a die.

*v. intr.*
To protrude or project.
(http://dictionary.reference.com/search?q=extruded&r=66)

**Allwords.com:**
*verb* extruded, extruding
1. To squeeze something or force it out.
2. To force or press (a semisoft solid material) through a die in order to mould it into a continuous length of product.

(http://www.allwords.com/query.php?SearchType=3&Keyword=Extruded&goquery=Find+it%21&Language=ENG)

The term "extruded" is not specifically defined in Applicant's specification. Consequently, in construing the claims, the term must be given its ordinary meaning in the art. As clearly established above, that meaning includes forcing or pressing a material through a die to create a length of product, in this case a pull tab.

In contrast, the cited prior art references do not teach or suggest a pull tab that comprises an *extruded* portion of same the media wrapper that the pull-tab is configured to split along a perforation. The Office Action cites Honma and Rosenberg as teaching the claimed extruded portion of the wrapper that constitutes a pull tab. (Action of 6/7/05, p. 3).

However, Honma merely teaches a "tearing tab" (16) without ever teaching or suggesting that the tearing tab "comprises an extruded portion" of a media wrapper. To the contrary, the "tearing tab" (16) of Honma is made with "severing tape" (13) that is disposed *on* the packaging film (11). Honma does not teach or suggest a portion of the packaging film (11) is "extruded" to form the claimed pull-tab.

Rosenberg teaches a "box-board carton" (col. 1, line 25) that includes a "tear strip" (50) formed of the "box-board" material (col. 2, lines 57-64). Rosenberg does not teach or suggest an *extruded* portion of a media wrapper as claimed. Nothing in the Rosenberg carton is "extruded."

No prior art reference of record teaches or suggest the claimed "extruded portion" pull tab recited in claims 5 and 32. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

Consequently, for at least this reason, the rejection of claims 5 and 32 should be reconsidered and withdrawn.

Claim 6 recites:

> A ream of print medium in a media wrapper for use in a printing device comprising:
> a quantity of print medium configured to be automatically fed into a printing device for formation of images thereon; and
> a wrapper containing said quantity of print medium, said wrapper comprising:
> a first end;
> a second end;
> a perforation disposed between said first and second ends, wherein said perforation is configured to split said media wrapper to separate said first and second ends; and
> a placement indicator, wherein said placement indicator is configured to indicate a nap of said print medium.

(emphasis added).

Claim 12 recites:

> A ream of print media comprising:
> print media; and
> a print media wrapper including a first end, a second end, and a perforation disposed between said first and second ends, wherein said perforation is configured to split said media wrapper to separate said first and second ends;
> wherein said print media wrapper further comprises a placement indicator, said placement indicator being configured to indicate a preferred nap side of said print media.

(emphasis added).

Similarly, claim 33 recites:

> A packaged print medium in a media packaging wrapper for use in a document producing device comprising;
> a quantity of print medium;
> a wrapping means for wrapping said print medium;
> a separating means for separating said wrapping means, such that a first portion of said wrapping means is removed, while a second portion remains around said print medium providing support to said quantity of print medium; and
> indicating means for indicating a desired orientation of a nap of said media.

(emphasis added).

In contrast, none of the prior art references cited teaches or suggests the claimed placement indicator or indicating means that indicate "a nap of said print medium" or "a desired orientation of a nap of said media." According to the recent Office Action, Nakamura teaches the claimed placement indicator or indicating means indicating the nap of the print medium. (Office Action of 11/8/05, p. 3). This is incorrect.

Nakamura does not even mention the *nap* of the print medium. Nakamura merely teaches an "insertion arrow" (56, Fig. 12) that guides a user to insert the correct end of the package into the printer. Nakamura does not teach or suggest that this "insertion arrow" has any relationship to the nap of the print medium.

In the recent Office Action, it is argued that the "label or arrow of Nakamura is inherently capable for indicating a desired orientation of a nap of the media." (Action of 11/8/05, p. 5). Applicant agrees that the arrow taught by Nakamura could be used to indicate a desired orientation for a nap of the print media, ***but Nakamura contains no such teaching***. Consequently, the Office Action appears to be reading teachings into the Nakamura reference based on Applicant's disclosure when those teachings are not actually present in the prior art.

Specifically, it would *not* be true that the arrow taught by Nakamura "inherently" indicates the desired orientation of the nap. "Inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (citations omitted). "[T]he examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic ***necessarily*** flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis in original); see also, MPEP § 2112 (quoting Levy).

In the present case, as taught by Nakamura, the arrow (56) merely guides the user to the end of the packaging that can be removed and the subsequent insertion direction of the media into a printing device. As already noted, Nakamura does not even mention the media nap and does not teach or suggest any element that functions like the claimed "placement indicator being configured to indicate a preferred nap side of said print media."

No prior art reference of record teaches or suggests the claimed indicator or indicating means relating to the nap of the media. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Consequently, for at least this reason, the rejection of claims 6-8, 12 and 33-35 should be reconsidered and withdrawn.

Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: January 6, 2006

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